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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,683	02/24/2004	Sanjay M. Parekh	04159.0001US	8387
23859 7590 03/01/2007 NEEDLE & ROSENBERG, P.C. SUITE 1000 999 PEACHTREE STREET ATLANTA, GA 30309-3915			EXAMINER BARQADLE, YASIN M	
			ART UNIT	PAPER NUMBER

2153

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/785,683	PAREKH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yasin M. Barqadle	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 37-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/24/2004</u>  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

- Claims 37-61 are presented for examination.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "some" in claim 37 is a relative term which renders the claim indefinite. The term "some" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. The specification does not define what the term "some" stand for. Clarification is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and

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use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37,38,48 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "determining strings of characters associated with geographic naming conventions ..." the specification does not describe what strings of characters are associated with geographic naming conventions, in fact there is no mention in the specification as originally filed any thing about "strings of characters". Clarification is required. Examiner assumes strings of characters associated with geographic naming conventions as domain names or IP addresses.

Claims 37,38,48 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. "determining

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strings of characters associated with geographic naming conventions ..." the specification does not state what the strings of characters are, in fact there is no mention in the specification as originally filed any thing about "strings of characters associated with geographic naming conventions". It is not clear how strings of characters or what strings of characters are associated with geographic naming conventions. Examiner assumes strings of characters associated with geographic naming conventions as domain names or IP addresses.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-43, 45-58 and 60-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Ansell et al US (6151631).

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As per claims 37 and 48, Ansell et al discloses an automated computer-implemented method of determining geographic location of an Internet user, comprising:

receiving at least one of an IP address, host name or domain name associated with the Internet user [IP address or domain name of client computer is received. Col. 3, lines 13-37 and col. 5, lines 43-57];

obtaining a route through the Internet to the target host for the IP address, the route containing intermediate hosts; [trace route is used to obtain intermediate hosts Col. 2, lines 61-67 and Col. 3, lines 1-3];

determining strings of characters associated with geographic naming conventions for at least some of the intermediate hosts contained in the route "The trace routing process uses conventional trace routing to determine the approximate geographical position of client computer 160 (FIG. 1) and maps that geographical position to determine a geopolitical territory within which client computer 160 exists" [Col. 10, lines 19-40 and col. 8, lines 28-48];

determining geographic location associated with at least some of the intermediated hosts by use of a database correlating the strings of characters to geographic locations; address of an entity that owns the IP address [col. 9, lines 58-65; Col. 10,

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lines 19-40 and Col. 15, lines 18-38];

automatically determining the geographic location of the Internet user by analysis of the route and the geographic locations of at least some of the intermediate hosts ]in trace routing, geographical location of user (computer) in question is determined by sending a packet to the (computer) user in question. A status packets containing information regarding at which routing node (and the hops between end points, round-trip transmission time between each of a plurality of links from and entry point into the Internet to he desired computer) is sent back to the sender of conventional trace route command Col. 2, lines 61-67 and Col. 3, lines 1-3].

As per claim 38, Ansell et al discloses deriving the geographic location for unknown intermediate hosts within the route that does not have and associated string of associated with a geographic naming convention by determining the geographic location of an entity that owns the unknown intermediate host (col. 8, lines 49- to col. 9, line 10 and col. 9, lines 38-57)

As per claims 39 and 49, Ansell et al discloses storing the geographic location of the Internet user in a database along with the geographic locations of a plurality of other Internet

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users [Col. 10, lines 19-30 and Col. 2, lines 61-67 and Col. 3, lines 1-3].

As per claim 40, Ansell et al discloses determining a geographic address of an entity that owns the IP address [Col. 5, lines 1-43].

As per claims 41 and 57, Ansell et al discloses the method wherein the receiving one of the IP address or the domain name comprises receiving both the IP address and the domain name and method further comprises verifying that the IP address corresponds to the domain name [Col. 3, lines 13-31].

As per claims 42 and 58, Ansell et al discloses the method wherein the obtaining of the route through the Internet comprises performing a trace route [Col. 2, lines 61-67 and Col. 3, lines 1-3 and Col. 10, lines 14-30].

As per claim 43, Ansell et al discloses a method as set forth in claim 37, further comprising assigning a confidence level to the geographic location of the Internet user [Col. 8, lines 13-20].



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As per claims 45, and 50, Ansell et al disclose the method wherein automatically determining the geographic location of the Internet user comprises automatically determining a region within a country where the Internet user is located [Col. 6, lines 39-61].

As per claims 46 and 52, Ansell et al disclose a method as set forth in claim 37, wherein receiving comprises receiving a plurality of IP addresses or domain names associated with a plurality of Internet users and automatically determining comprises automatically determining geographic locations of the plurality of Internet users [Internet user's host Col. 3, lines 13-62].

As per claim 47, Ansell disclose the method further comprising receiving queries for the geographic location of the Internet user and returning the geographic location [col. 3, lines 26-31 and col. 5, lines 43-65].

As per claim 51, wherein determining a first geographic location of the intermediate host comprises using a database associating a plurality of strings of characters with geographic locations [Col. 10, lines 19 to col. 11, line 50].

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As per claim 53, Ansell disclose the method of claim 48, wherein the route contains a plurality of intermediate hosts and a geographic location is determined for each intermediate host [A status packets containing information regarding at which routing node (and the hops between end points, round-trip transmission time between each of a plurality of links from and entry point into the Internet to he desired computer) is sent back to the sender of conventional trace route command Col. 2, lines 61-67 and Col. 3, lines 1-3; Col. 10, lines 19-30].

As per claim 54, Ansell et al discloses a wherein automatically determining the geographic location of the target host comprises analysis of the route and the geographic locations of the intermediate hosts Col. 2, lines 61-67 and Col. 3, lines 1-3; Col. 10, lines 19-30

As per claim 55, Ansell et al discloses the method of claim 1, further comprising determining a confidence level associated with the geographic location of the intermediate host [Col. 9, lines 2-37 and col. 10, lines 1-30].

As per claim 56, Ansell et al discloses the method of claim 1, further comprising determining a confidence level associated

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with the geographic location of the target host [Col. 9, lines 2-37 and col. 10, lines 1-30].

As per claim 60, Ansell et al disclose a method as set forth in claim 1, wherein automatically determining the geographic location of the Internet user comprises automatically determining a region within a country where the Internet user is located [Col. 6, lines 39-61].

As per claim 61, Ansell disclose the method of claim 50, further comprising receiving queries for the geographic location of the Internet user and returning the geographic location [col. 3, lines 26-31 and col. 5, lines 43-65].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 44 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansell et al US (6151631) in view of Merriman et al US (5948061).

As per claims 44 and 59, although Ansell et al shows substantial features of the claimed invention, he does not explicitly show a city where the Internet user is located.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Ansell et al, as evidenced by Merriman et al USPN. (5948061).

In analogous art, Merriman et al disclose a system for determining the geographic location of Internet user down to specific location of the user through phone number and the location address. [Col. 7, lines 46 to col. 8, line 23].

Giving the teaching of Merriman et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Ansell et al by employing the system of Merriman et al to have the advantage of locating the geographic location of an Internet with more precision.

### **Conclusion**

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin Bargadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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KRISNA LIM  
PRIMARY EXAMINER